

**REMARKS**

Claims 1-28, 30 and 31 are pending in the present application. In summary of the outstanding Office Action, claims 1-18, 20, 21, 23, 26, 27 and 31 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,572,442 (Schulhof et al.). Claim 19 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al. in view of U.S. Patent No. 6,272,636 (Neville et al.). Claims 22, 24, 25 and 28-30 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al.

Reconsideration of the outstanding rejections to the claims is respectfully requested in view of the following remarks.

***Claim rejections under 35 U.S.C. §102***

Claims 1-18, 20, 21, 23, 26, 27 and 31 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,572,442 (Schulhof et al.). Regarding claim 1, the Office Action contends that the language of claim 1 regarding selected previously recorded music and communicating information regarding previously recorded music is taught by Schulhof et al., as content described in Schulhof et al. is recorded in a library prior to being transferred to a user. However, as amended to clarify limitations inherent in the originally presented claim, claim 1 requires the customer to “select previously recorded music selections that were previously recorded by the *customer household* in the *storage medium*.” The storage medium is that which the customer uses to record selections. In contrast, as the Office Action states, the library described in Schulhof et al. has content that is recorded in the library *prior* to being transferred to a user (see also figure 1).

Thus, for the reasons above and others, Applicant submits that all the limitations of claim 1 are not taught or suggested by Schulhof et al.

Regarding claim 2-18, 20, 21, 23, 26, 27 and 31, the Office Action gives the same reason as for claim 1 in rejecting these claims. A corresponding amendment to that made in claim 1 was also made for clarification in the other claims sharing that common element with claim 1. Thus, Applicant submits that all the limitations of claims 2-18, 20, 21, 23, 26, 27 and 31 are not taught or suggested by Schulhof et al. for the same reasons as claim 1.

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**Application No.: 09/476,078**  
**Office Action Dated: July 13, 2004**

**PATENT**  
**REPLY FILED UNDER EXPEDITED**  
**PROCEDURE PURSUANT TO**  
**37 CFR § 1.116**

Since all the limitations of claims 1-18, 20, 21, 23, 26, 27 and 31 are not taught or suggested by Schulhof et al., as shown above, withdrawal of the rejections under 35 U.S.C. § 102(b) for these claims is earnestly solicited.

***Claim rejections under 35 U.S.C. §103***

Claim 19 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al. in view of U.S. Patent No. 6,272,636 (Neville et al.). Claims 22, 24, 25 and 28-30 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al.

Regarding claim 19, 22, 24, 25 and 28-30, they either depend from claims 1 or 10, or were rejected for the same reasons as claims 1 or 10 with respect to elements shared in common with claims 1 or 10. Therefore, Applicant respectfully submits that all the limitations of claims 19, 22, 24, 25 and 28-30 are not taught or suggested by Schulhof et al., Neville et al., or any combination thereof, for the same reasons presented above.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2142. Since all the limitations of claims 19, 22, 24, 25 and 28-30 are not taught or suggested by Schulhof et al., Neville et al., or any combination thereof, for the same reasons presented above, withdrawal of the rejections under 35 U.S.C. § 103(a) for claims 19, 22, 24, 25 and 28-30 is earnestly solicited.

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### **CONCLUSION**

Applicants believe that the present Amendment is responsive to each point raised by the Examiner in the office action and Applicants submit that claims 1-28, 30 and 31 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner's earliest convenience is earnestly solicited. **However, should the Examiner find the claims as presented herein to not be allowable for any reason, Applicants' undersigned representative earnestly requests a telephone conference at (206) 332-1392 with both the Examiner and the Examiner's Supervisor to discuss the basis for the Examiner's continued rejection in light of the Applicants' arguments presented herein and amendments made to emphasize the Applicants' arguments.** Likewise, should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative would very much appreciate a telephone conference to discuss these issues.

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